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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/747,651
Filing Date: December 22, 2000
Appellant(s): ROLLINS ET AL.

Anita Choudhary
For Appellant

EXAMINER'S ANSWER

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This is in response to the appeal brief filed August 2, 2005, appealing from the Office action mailed May 2, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

U.S. Patent Application 09/747,656

U.S. Patent Application 09/747,666

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,499,042	MARKUS	12-2002
6,490,601	MARKUS	12-2002
5,890,138	GODIN ET AL	3-1999
6,285,776	RHOADS	9-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7 and 21 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 7 and 21 recite a "tracer image". It is unclear based on the description in the specification and claims, how the tracer image is implemented in the present invention, and

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specifically what it's function is. As best understood, the tracer image appears to be some sort of authentication or other security measure, to restrict access to information.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4, 6, 8-10, 12-16, 18, 20, 22-24, and 26-29, are rejected under 35

U.S.C. 102(e) as being anticipated by Markus (U.S. Patent No. 6,499,042).

10. With respect to claims 1, 2, 4, 6, 15, 16, 18, and 20, Markus discloses a method for processing requests from a client (web browser 13) for electronic documents (17) located at a server (document server 15), comprising the steps of receiving, by an intermediary (selective proxy 14) disposed between the client (document browser) and server (document server, see figure 1) a request (column 3, lines 29-31) from the client for an electronic document located at a first address at the server. The request is made by a user (external entity) at the client. The intermediary (14) retrieves the electronic document from the first address (on document server 15, column 3, lines 36-38) and information associated with the user (in task 26). An updated electronic document is generated (by filling in blank fields) from the retrieved electronic document that includes at least a portion of the information associated with the user. The updated electronic document is provided to the client (13) in response to the request (column 3, lines 42-43). Additionally, Markus discloses receiving validation data from the user and

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validating the validation data (column 3, lines 30-32). The information associated with the user is stored via an Internet cookie (Abstract). The electronic document is a web page, and the updated electronic document is a web page generated by an integrated order mechanism.

With respect to claims 8-10 and 22-24, Markus discloses the information associated with the user to be retrieved via a post from a server. The examiner considers the contacting of the Selective Proxy to be a post from a server. Markus also discloses the request from the user to be received at an intermediary (14), wherein the electronic document is stored on a server (document server 15), wherein the retrieving the electronic document comprises the steps of sending a new request from the intermediary (14) to the server (15, column 3, lines 36-38), and receiving at the intermediary, the electronic document from the server. Markus also discloses the information associated with a user to be retrieved from a wallet server. The user information in Markus is retrieved from the selective proxy. Because the selective proxy contains personal information, the examiner considers it a wallet server.

With respect to claims 12-14 and 26-28, Markus discloses the step of generating the electronic document to comprise generating the updated electronic document by updating one or more data fields based upon information associated with the user. Markus also determines whether one or more variables included in the electronic document include valid user data and revises the electronic document by substituting one or more data values from the user information. Examiner asserts that a blank field is not valid user data. Markus fills blank fields with valid user data. Furthermore, Markus determines whether one or more variables in the electronic document correspond to at least one of a plurality of data values, when one or more variable does not correspond, Markus examines the context in which each of the variables is

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used, identifies a particular data value from the plurality of data values, and substitutes the particular data value (column 3, lines 39-41, "processed in the context...").

With respect to claim 29, Markus discloses a method for processing requests from a client (13) for electronic documents located at a server (15) comprising an intermediary (selective proxy 14), and a server that is associated with an electronic document (document server 15) located at a first address at the server, wherein the intermediary (14, column 3, lines 36-38), in response to a request from the client made by a user (external entity) at the client, retrieves the electronic document (17) from the first address and information associated with the user and generates an updated electronic document from the retrieved electronic document (by filling in blank fields) including at least a portion of the information associated with the user.

With respect to claims 30 and 31, the intermediary (14) is neither the client (13) nor the server (15).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markus ("Markus '042") in view of Markus et al ("Markus '601", U.S. Patent No. 6,490,601). While Markus '042 suggests that storing information associated with the user may be used with one or more other electronic documents, it is not specifically disclosed.

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Markus '601 teaches that stored user information may be used with one or more other electronic documents. This allows the user information to be automatically filled in forms from a plurality of websites that are affiliate members of the service (column 7, line 63 – column 8, line 12). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Markus '042 so that the user information may be used with one or more other electronic documents, so that the user only has to register information at one central location.

Claims 5, 11, 19, 25, are rejected under 35 U.S.C. 103(a) as being unpatentable over Markus in view of Godin et al ("Godin", U.S. Patent No. 5,890,138). Markus discloses personal information to be stored in a cookie, and to be retrieved when needed. Because this cookie stores personal information, the examiner considers it a wallet cookie. However, Markus fails to disclose the information to be stored in an encrypted format.

Godin teaches an online auctioning system where the user may pre-register personal information, such as an I.D. number, and financial information, and store this information on a database, to allow for automated payment. The information is encrypted on the database. Encrypting this sensitive personal information limits access to the information by an unauthorized party. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to encrypt the stored user information of Markus as taught by Godin, so as to limit, and prevent access to the user's personal information. This information is retrieved in order to pay for an item.

Claims 7 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markus in view of Rhoads (U.S. Patent No. 6,285,776). Markus fails to disclose the user information to be retrieved via the use of a tracer image.

Rhoads teaches the use of a tracer image to identify a specific article can be identified through use of a detecting apparatus. This makes identifying marks difficult for unauthorized persons to recognize without proper equipment. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Markus by including a tracer image to identify a user, and retrieve the associated user information, so as to provide discrete way of identifying the user.

(10) Response to Argument

As an initial note, page 13 of appellant's brief, section VIII, indexes three parts to an appendix. The only appendix included with this brief is appendix C. However, the index notes for appendix A ("Evidence") and appendix B ("Related Proceedings") that there is none. This is considered to meet the requirements of the appeal brief because it positively states there is no appendix included for the evidence and related proceedings.

Regarding independent claims 1, 15, and 29, appellant argues that Markus '042 fails to disclose the limitation, "receiving, by an intermediary disposed between the client and server, a request from the client for an electronic document located at a first address at the server". Examiner disagrees. Markus '042 provides for three main elements: document browser (13), selective proxy (14), and document server (15), which examiner considers analogous to the client, intermediary, and server, respectively, as presented in the claims. Figure 1 of Markus

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'042 shows the selective proxy acting as an intermediary. Further, Markus describes the selective proxy as a "piece of software that sits between a Document Browser and Document Server" (column 2, lines 27-28). In operation, the selective proxy, or intermediary, receives a request from the client at 20 (see figure 3). This request initiates the process. If the client cannot be identified, they must enter log in information. In 24, the selective proxy contacts that document server and requests the document (column 3, lines 28-40). The electronic document *must* be located at a first address on the server in order to be found and identified to be sent to the selective proxy. Additionally, Markus discusses a location identifier, such as a URL, of a form originating server (column 1, lines 21-23). In this case, the form-originating server is the document server, and the URL provides an address at the server. Therefore, Markus explicitly discloses a client, intermediary, and document server, as discussed above. The intermediary receives a request from the client (at 20) for an electronic document. The document is located at a first address on the server.

Appellant continues to argue that Markus '042 shows only a request for filling out a form, not for an electronic document located at a first address at a server, and concludes that this is not a request for an electronic document. Examiner disagrees. When the autofill trigger is activated at step 19, this request is sent to the selective proxy, or intermediary. The selective proxy then requests the document from the document server (column 3, lines 35-40). The autofill trigger serves as a request for the document located at a first address on the document server because the trigger results in the document being retrieved. This meets all the limitations of claims 1, 15, and 29. In terms of figure 3 in Markus '042, the claimed steps are depicted as steps 19, 20, and 24. It is noted that steps 21-23 are optional steps in the case of login

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information being required. Again, the autofill trigger at 19 and 20, results in a request at the selective proxy, or intermediary, for a document located at the document server, as shown by step 24.

With respect to claims 2, 4, 6, 8, 12, 18, 20, 23, 26, 30, and 31, appellant's arguments fail specifically point out reasons for patentability beyond their dependence from independent claims 1 and 15. Claims 1 and 15 are rejected for the reasons discussed above. Therefore, these claims remain rejected as presented in the Office Action of May 2, 2005, and repeated in the "Grounds of Rejection" section above.

With respect to claims 8 and 22, appellant argues the claim limitation of "retrieving, via a post from a server, information associated with the user" is not shown by Markus '042. Appellant further argues that the POST command has a commonly understood definition in the art. Examiner respectfully disagrees. Markus '042 retrieves the information associated with the user, from a cookie or other previously saved information at the selective proxy, not from the login information as appellant contends. This information associated with a user is posted in step 26 (see figure 3). Markus '042 continues to refer to the "posted form data" in column 3, lines 61, 62. Thus, step 26 shows the posting of information associated with a user. This information is retrieved as a result of the post at a server.

With respect to claims 10 and 24, appellant argues that no evidence has been cited to show that the selective proxy in Markus '042 is a wallet server. Examiner respectfully disagrees.

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Examiner contends that the selective proxy is a wallet server because it contains personal user information, something that could be found in a person's wallet. Appellant has not brought forth any evidence that the selective proxy is not a wallet server in response to the examiner's position for considering the selective proxy to meet the limitation of a wallet server. Further, the claim does not define a wallet server any further than mentioning it by name. Step 26 shows personal user data being filled into a form. This occurs at the selective proxy. Thus, personal user information is retrieved from the selective proxy and inserted into the form. This information is not retrieved from a user's login information as appellant contends. The login information is used only to verify a user.

With respect to claims 13 and 27, appellant argues that the filling of empty data fields in Markus '042 is not the same as determining whether one or more variables include in valid user data". Examiner respectfully disagrees. Examiner holds that a blank field in the form is not valid user data, and Markus '042 fills the blank fields with valid user data. Appellant continues to state that filling a blank field is clear not the same as revising by substituting one or more data values. Appellant fails to provide any evidence as to how this is not the same. By considering a blank field as invalid user data, every limitation of these claims has been met. Appellant has failed to present how these limitations are not met by examiner's position. Appellant also appears to be referring the portion of Markus '042 where a step of manual verification is described. Examiner notes that this is not portion of Markus '042 is not relied upon in the rejection. The portion of Markus '042 relied upon is column 3, lines 38-44, where the filling of blank form field with relevant information is discussed.

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With respect to claims 14 and 28, appellant argues the filling of empty form fields is not the same as examining context of empty form fields within the electronic document, nor is it the same as identifying a data value that conforms to the context within the electronic document as claimed. Appellant fails to show any evidence how these are not the same. Column 3, lines 39-41 in Markus states that “all the empty form fields in the document are filled with relevant information”. Examiner holds that for relevant information to be placed in the correct field, the context of the empty form fields must be examined. By examining the context, the “relevant” information in Markus ‘041 can be placed in the correct field. Additionally, a data value (any digital information is a data value) is identified that conforms to the context of the electronic document. Again, any user information is considered to be the data value. This information is identified to conform to the context of the electronic document; otherwise, the information would not be “relevant” as Markus ‘042 requires. Appellant has not refuted this position, but merely makes an unsupported allegation that disclosure of Markus ‘042 and the claimed limitations are different. Examiner asserts the disclosure of Markus ‘042 meets every limitation set forth in the claim for the reason discussed above.

With respect to claims 3 and 17, appellant argues the combination of Markus ‘042 and Markus ‘601 fails to address the deficiencies of Markus ‘042 in the independent claims. Appellant has failed to set forth a specific argument regarding how the language of the claim patentably distinguishes them from the references. As such, the rejection on claims 3 and 17 is maintained for the reasons discussed in the Office Action of May 2, 2005, and repeated in the “Grounds of Rejection” section above.

With respect to claims 5, 11, 19, and 25, appellant argues that examiner has relied on non-analogous art in citing the Godin et al patent (hereinafter "Godin"). Examiner respectfully disagrees. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, In this case, Godin is reasonably pertinent to the particular problem to be with which the appellant was concerned. Appellant state that the instant application is concerned with problems associated with securely processing orders over the Internet, including the completion of order forms and payment of commissions to shopping applications and portals. It is noted that Markus '042 addresses issue regarding the completion of order forms and processing orders over the Internet. The issue of payment of commissions is not explicitly addressed in the claims. Markus fails to disclose that issue of *securely* processing the orders over the Internet. Appellant addresses this issue by claiming user information is to be stored in an encrypted format. Godin is reasonably pertinent to this issue. Godin teaches a system where a user obtains an I.D. number that is combined with certain financial information and is retained in a database in an encrypted format (column 4, lines 41-44). This is reasonably pertinent to securely processing an order, as it protects a user's financial and other personal data.

Appellant notes examiner's acknowledgment that Markus '042 fails to disclose "retrieving information associated with the user from an encrypted wallet cookie". Examiner acknowledges that Markus '042 fails to disclose encrypted information. However, as presented

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in the Office Action of May 2, 2005, examiner contends that Markus '042 does disclose the information to be retrieved from a wallet cookie. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). It is noted that Markus '042 teaches every limitations of claims 5, 11, 19, and 25, including a wallet cookie. However' Markus '042 does not teach this wallet cookie to be encrypted, as claimed. Godin teaches an online auction system where a user's personal information, including certain financial information, is stored in an encrypted format (column 1, lines 41-44). This personal information is similar to information commonly found in wallet cookies. The encryption secures the information and prevents unauthorized use or access to the personal information. One having ordinary skill in the art would recognize that, based on the teachings of Godin, personal information can be encrypted to prevent unauthorized use and access to the information, which in turn creates a more secure commercial environment. Thus, based on the teachings of Godin, one of ordinary skill in the art would be motivated to encrypt the wallet cookie of Markus '042 for increased security and data protection.

With respect to claims 7 and 21, appellant argues that the Rhoads patent is non-analogous art. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Rhoads is reasonably

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pertinent to the particular problem with which the applicant is concerned. Examiner notes claims 7 and 21 deal with a “tracer image”. As best understood, the tracer image is some sort of a security or authentication feature. Rhoads uses the tracer image to identify a specific article can be identified through use of a detecting apparatus. This makes identifying marks difficult for unauthorized persons to recognize without proper equipment. Therefore, Rhoads is pertinent to the problem with which applicant is concerned. A valid tracer image will allow data to be retrieved in the combination of Markus ‘042 and Rhoads. It is noted that Markus ‘042 discloses addresses processing orders over the Internet. Rhoads is cited solely for teaching a tracer image.

Appellant further argues that Rhoads does not suggest receiving information associated with the user via a tracer image. Examiner respectfully disagrees. Rhoads teaches a tracer image in a banknote. If the banknote is copied, the tracer data will be transferred, and make it possible to identify the equipment used in the reproduction. The tracer image stores data, such as a serial number (abstract). This data can be retrieved. One having ordinary skill in the art would look to the teachings of Rhoads for the transfer of data using a tracer image, to discretely provide user information.

Appellant also argues that claims 7 and 21 particularly point out and distinctly claim the subject matter as required under 35 U.S.C. 112, second paragraph. Examiner respectfully disagrees. Appellant relies on passages in the specification on pages 26-28 which describe how a tracer image can be used. However, they do not enable one of ordinary skill in the art to identify what a tracer image actually is, rather than how it works in different applications. It remains unclear how the tracer image is used in the present invention, and how the data is retrieved from it.

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(11) Related Proceeding(s) Appendix

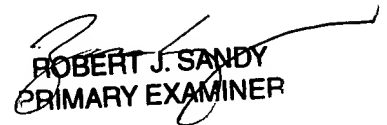
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the reasons above, it is believed the rejections should be sustained.

Respectfully submitted,

mk

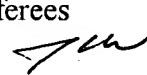
October 28, 2005


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